REMARKS

The Office Action dated May 6, 2004 has been carefully reviewed and the following remarks have been made in consequence thereof.

Claims 1-18 are pending in this application. Claims 1-18 stand rejected.

The rejection of Claims 1-18 under 35 U.S.C. § 103(a) as being unpatentable over Haq et al. "Haq", (U.S. Patent No. 6,275,812) in view of Tuttle (U.S. Patent 6,591,246) is respectfully traversed.

Haq describes a system and method for human resource skill management, training, career development, and deployment for the employees of a company. The system compares the employees' skills to skills required for a position within the company in a one to one correspondence. The method uses skill templates that enable a project manager to compare the employees skills with skills that are required by each member of the project team to assess the employee's suitability for a position. A weighting system is also used to establish the relative significance of various skills. An assessment of an employee's suitability for a project within the company is based on a quantitative evaluation and not based on subjective considerations.

Tuttle describes a method of providing updated assessment data on available resources such as workforce technical skills for marketing purposes as well as to identify skill shortages to be rectified by employee training or recruitment, match employee skills to workload and centralize employee data statistics not readily available from personnel records. The method is implemented using computer operated program that establishes a data base table by collecting information from which reports are provided to managers for assessments and analyses of technical skills of workforce employees. Such reports embody extraction of employee statistics from personnel records for identification of skill shortages and matching of employee skills with workloads. The database utilizes a mission numbering system that acts as a single indenturing code for stages of the program interfacing with other numerical code identifications used in strategic and workload planning as well as being consistent with denoting technical skill levels. A detailed data table is established by the program utilizing data collected in a consistent format, to provide skill level assessment. Database extracted reports also provide for statistical analysis of the entire workforce of employees or selected

portions thereof formed for example as departments, directorates or groups. Notably, Tuttle does not describe nor suggest any subjective qualities desired in a candidate, such as analytical ability, self-confidence, initiative, change orientation, and interpersonal skills. Rather, at column 1, lines 5-7, Tuttle describes "a method of providing updated assessment data on available resources such as workforce technical skills." At column 1, lines 25-29, Tuttle describes "a computer operated program establishes a data base table by collection of information...for assessments and analyses of technical skills of workforce employees." Tuttle also describes:

> ...the employee information collected for input into the program 10 through entry stage 14, falls within nine different employee identifying and skill influencing categories as diagrammed in FIG. 2. Such categories consists of: 1) employee social security numbers (SSN); 2) educational background information such as schools and graduation dates, 3) technical or professional society memberships, 4) technical and administrative licenses, 5) patents granted to the employee, 6) publications of the employee applicable to the mission, 7) foreign languages of the employee, 8) information on employee awards and 9) mission related skills falling within four different levels respectively assigned numerical values for coding purposes...

Tuttle, column 2, line 56 to column 3 line 1. Tuttle merely describes collecting and inputting information relating to employees' technical skills, analyzing the technical skills, and generating reports using the employees' technical skills, but Tuttle does not describe nor suggest any qualities desired in a candidate, such as analytical ability, self-confidence, initiative, change orientation, and interpersonal skills.

Further, and to the extent understood, no combination of Haq and Tuttle, considered alone or in combination,, describes or suggests the claimed combination, and as such, the presently pending claims are patentably distinguishable from the cited combination. Specifically, Claim 1 recites a method for determining candidates to interview that includes "providing pre-determined desired qualities for a candidate, the desired qualities include at least two of analytical ability, self-confidence, initiative, change orientation, and interpersonal skills...determining if the candidate possesses at least one of a plurality of independent characteristics, a predetermined combination of characteristics being indicative of a degree to which the candidate possesses the desired qualities...generating a database

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including at least one characteristic for each candidate wherein the at least one characteristic is correlative to the desired qualities...normalizing the characteristics, normalizing includes comparing a total number of characteristics, possessed by the candidate, of a combination of characteristics that determine each desired quality, to a total number of possibly possessed characteristics for the desired quality, and assigning a value to each desired quality based on the comparison...displaying results for each candidate based on the desired quality values...selecting at least one candidate to interview based on the desired quality values."

Neither Haq nor Tuttle, considered alone or in combination, describes or suggests a method for determining candidates to interview as recited in Claim 1. More specifically, no combination of Haq and Tuttle, considered alone or in combination, describes or suggests a method for determining candidates to interview that includes providing pre-determined desired qualities for a candidate wherein the desired qualities include at least two of analytical ability, self-confidence, initiative, change orientation, and interpersonal skills. Moreover, no combination of Haq and Tuttle, considered alone or in combination, describes or suggests determining if the candidate possesses at least one of a plurality of independent characteristics wherein a predetermined combination of the characteristics are indicative of a degree to which the candidate possesses the desired qualities. Additionally, no combination of Haq and Tuttle, considered alone or in combination, describes or suggests generating a database including at least one characteristic for each individual wherein the at least one characteristic is correlative to the desired qualities. Further, no combination of Haq and Tuttle, considered alone or in combination, describes or suggests normalizing the characteristics wherein normalizing includes comparing a total number of characteristics, possessed by the candidate, of a combination of characteristics that determine each desired quality, to a total number of possibly possessed characteristics for the desired quality, and assigning a value to each desired quality based on the comparison. Rather, Haq describes a method of optimizing the assignment of present employees of a company to positions based upon a multi-factored analysis of a database of the employees skills set, and Tuttle describes a method for generating reports for assessing comparative technical skills of employees.

Applicants respectfully submit that the Section 103 rejection of the presently pending claims is not a proper rejection. Obviousness cannot be established by merely suggesting that it would have been an obvious to one of ordinary skill in the art to modify Haq. according to the teachings of Tuttle. More specifically, it is respectfully submitted that a prima facie case

of obviousness has not been established. As explained by the Federal Circuit, "to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant." In re Kotzab, 54 USPQ2d 1308, 1316 (Fed. Cir. 2000). MPEP 2143.01.

Moreover, the Federal Circuit has determined that:

[I]t is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."

In re Fitch, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992). Further, under Section 103, "it is impermissible . . . to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." In re Wesslau, 147 USPQ 391, 393 (CCPA 1965). Rather, there must be some suggestion, outside of Applicants' disclosure, in the prior art to combine such references, and a reasonable expectation of success must be both found in the prior art, and not based on Applicants' disclosure. In re Vaeck, 20 U.S.P.Q.2d 1436 (Fed. Cir. 1991). In the present case, neither a suggestion nor motivation to combine the cited art, nor any reasonable expectation of success has been shown.

Although it is asserted within the Office Action that Haq teach the present invention except for disclosing desired qualities including at least two of analytical ability, self-confidence, initiative, change orientation, and interpersonal skills, and that Tuttle teaches the desired qualities include at least two of analytical ability, self-confidence, initiative, change orientation, and interpersonal skills, no motivation nor suggestion to combine Tuttle with Haq has been shown. The Office Action asserts that Tuttle's teaching of the desired qualities include at least two of analytical ability, self-confidence, initiative, change orientation, and interpersonal skills is found at column 2, lines 60-67, but rather, at column 2, lines 60-67, Tuttle describes:

...the employee information collected for input into the program 10 through entry stage 14, falls within nine different employee identifying and skill influencing categories as diagrammed in FIG. 2. Such categories consists of: 1) employee social security numbers (SSN); 2) educational background information such as schools and graduation dates, 3) technical or professional society memberships, 4) technical and administrative licenses, 5) patents granted to the employee, 6) publications of the employee applicable to the mission, 7) foreign languages of the employee, 8) information on employee awards and 9) mission related skills falling within four different levels respectively assigned numerical values for coding purposes...

Tuttle, column 2, lines 60-67. Applicants respectfully submit that the information described as being collected and input by Tuttle is life milestone information that is not equivalent to the "pre-determined desired qualities for a candidate wherein the desired qualities include at least two of analytical ability, self-confidence, initiative, change orientation, and interpersonal skills" as recited in Claim 1, but, is rather objective information harvested from employee records for assessing technical skills. Additionally, Applicants respectfully submit that the "technical skills" as recited in Tuttle, cannot fairly be equated with the "desired qualities" claimed in the present invention because they do not share a common essential feature.

Since there is no teaching nor suggestion in the cited art for the claimed combination, the Section 103 rejection appears to be based on a hindsight reconstruction in which isolated disclosures have been picked and chosen in an attempt to deprecate the present invention. Of course, such a combination is impermissible, and for this reason alone, Applicants request that the Section 103 rejection of Claims 1-18 be withdrawn.

Accordingly, for at least the reasons set forth above, Applicants respectfully submit that Claim 1 is patentable over Haq in view of Tuttle.

Claims 2-5 depend from independent Claim 1. When the recitations of Claims 2-5 are considered in combination with the recitations of Claim 1, Applicants submit that dependent Claims 2-5 likewise are patentable over Haq in view of Tuttle.

Claim 6 recites a selection system for determining candidates to interview that includes "a database comprising at least one independent characteristic for each candidate, and pre-determined dependent desired qualities for a candidate wherein the desired qualities include at least two of analytical ability, self-confidence, initiative, change orientation, and interpersonal skills and wherein the at least one characteristic is correlative to the desired qualities, a predetermined combination of characteristics being indicative of a degree to which the candidate possesses the desired qualities...a processor programmed to: determine if the candidate possesses the at least one independent characteristic...normalize the characteristics by comparing a total number of characteristics, possessed by the candidate, of a combination of characteristics that determine each desired quality, to a total number of possibly possessed characteristics for the dependent desired quality, and assigning a value to each of the desired qualities...display results for each candidate based on the desired quality values."

Neither Haq nor Tuttle, considered alone or in combination, describes or suggests a selection system for determining candidates to interview as recited in Claim 6. More specifically, no combination of Haq and Tuttle, considered alone or in combination, describes or suggests a selection system for determining candidates to interview that includes a database including at least one characteristic for each candidate, and pre-determined desired qualities for a candidate wherein the desired qualities include at least two of analytical ability, self-confidence, initiative, change orientation, and interpersonal skills and wherein the at least one characteristic is correlative to the desired qualities and wherein a predetermined combination of the characteristics is indicative of a degree to which the candidate possesses the desired qualities. Moreover, neither Haq nor Tuttle, considered alone or in combination, describes or suggests a processor programmed to normalize the characteristics by comparing a total number of characteristics, possessed by the candidate, of a combination of characteristics that determine each desired quality, to a total number of possibly possessed characteristics for the dependent desired quality. Furthermore, neither Haq nor Tuttle, considered alone or in combination, describes or suggests a processor programmed to display results for each candidate based on the desired quality values. Rather, Haq describes a method of optimizing the assignment of present employees of a company to positions based upon a multi-factored analysis of a database of the employees skills set, and Tuttle describes a method for generating reports for assessing comparative technical skills of employees.

Accordingly, for at least the reasons set forth above, Applicants respectfully submit that Claim 6 is patentable over Haq in view of Tuttle.

Claims 7-11 depend, directly or indirectly, from independent Claim 6. When the recitations of Claims 7-11 are considered in combination with the recitations of Claim 6, Applicants submit that dependent Claims 7-11 likewise are patentable over Haq.

Claim 12 recites an apparatus for screening candidates to interview that includes a processor having a memory and programmed to "a processor comprising a memory and programmed to "generate a database comprising at least one characteristic for each candidate, and pre-determined desired qualities for a candidate wherein the desired qualities include at least two of analytical ability, self-confidence, initiative, change orientation, and interpersonal skills, and wherein the at least one characteristic is correlative to the desired qualities, a predetermined combination of characteristics being indicative of a degree to which the candidate possesses the desired qualities...determine if the candidate possesses the at least one independent characteristic...normalize the characteristics by comparing a total number of characteristics, possessed by the candidate, of a combination of characteristics that determine each desired quality, to a total number of possibly possessed characteristics for the dependent desired quality, and assigning a value to each of the desired qualities...display results for each candidate based on the desired quality values."

Neither Haq nor Tuttle, considered alone or in combination, describes or suggests an apparatus for screening candidates to interview as recited in Claim 12. More specifically, no combination of Haq and Tuttle, considered alone or in combination, describes or suggests an apparatus for screening candidates to interview that includes a database having at least one characteristic for each candidate, and pre-determined desired qualities for a candidate wherein the desired qualities include at least two of analytical ability, self-confidence, initiative, change orientation, and interpersonal skills, and wherein the at least one characteristic is correlative to the desired qualities, wherein a predetermined combination of characteristics is indicative of a degree to which the candidate possesses the desired qualities. Moreover, no combination of Haq and Tuttle, considered alone or in combination, describes or suggests a processor programmed to normalize the characteristics by comparing a total number of characteristics, possessed by the candidate, of a combination of characteristics that determine each desired quality, to a total number of possibly possessed characteristics for the dependent desired quality, and assigning a value to each of the desired qualities. Further,

neither Haq and Tuttle, considered alone or in combination, describes or suggests a processor programmed to display results for each candidate based on the desired quality values. Rather, Haq describes a method of optimizing the assignment of employees to positions based upon a multi-factored analysis and database. Although Haq discusses a system that enables employees to assess what specific skills are needed to perform a job function, and Tuttle describes a method for generating reports for assessing comparative technical skills of employees, neither Haq nor Tuttle describes or suggests a database having pre-determined desired qualities for a candidate wherein the desired qualities include at least two of analytical ability, self-confidence, initiative, change orientation, and interpersonal skills, nor at least one characteristic that is correlative to the desired qualities and wherein a predetermined combination of characteristics is indicative of a degree to which the candidate possesses the desired qualities.

Accordingly, for at least the reasons set forth above, Applicants respectfully submit that Claim 12 is patentable over Haq in view of Tuttle.

Claims 13-18 depend, directly or indirectly, from independent Claim 12. When the recitations of Claims 13-18 are considered in combination with the recitations of Claim 12, Applicants submit that dependent Claims 13-18 likewise are patentable over Haq in view of Tuttle.

For at least the reasons set forth above, Applicants respectfully request that the 35 U.S.C. § 103(a) rejection of Claims 1-18 be withdrawn.

In view of the foregoing remarks, all the claims now active in this application are believed to be in condition for allowance. Reconsideration and favorable action is respectfully solicited.

Respectfully Submitted,

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